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09/519,546	03/06/2000	Frederik Ekkel	US-000014	8972

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EXAMINER

CHANG, ERIC

ART UNIT

PAPER NUMBER

2185

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/519,546	EKKEL ET AL.	
	Examiner	Art Unit	
	Eric Chang	2185	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06 March 2000.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-19 is/are rejected.

7) Claim(s) 1-19 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 31 May 2000 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

 a) All b) Some * c) None of:

 1. Certified copies of the priority documents have been received.

 2. Certified copies of the priority documents have been received in Application No. _____.

 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

 * See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-4.

4) Interview Summary (PTO-413) Paper No(s). _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

1. Claims 1-19 are pending.

Specification

2. The abstract of the disclosure is objected to because “CE” is used to describe the equipment in the abstract, but “CE” is never specifically defined. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities: there are a number of grammatical and typographical errors. For example, on page 4, “highly suitable fore this kind of interaction” should read “highly suitable for this kind of interaction”, and “into the first system or into a another” should read “into the first system or into an another”. Appropriate correction is required.

4. The disclosure is objected to because of the following informalities: there are a number of sentences that do not grammatically parse into idiomatic English. One such example is on page 4, which reads, “The user-group that is characterized by being ‘non-PC initiated’, although probably as interested as any to watch what they want when they want, would be deprived of these features”. Appropriate correction is required.

5. The disclosure is objected to because of the following informalities: there are a number of non-sequitur statements. One such example is the paragraph on page 7, which begins, “The third

level of tasks relates"; it is unclear how the last two sentences relate to the preceding sentences. Appropriate correction is required.

6. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

8. The following title is suggested: "USING A WEB-ENABLED DEVICE TO PROGRAM AND CONFIGURE DEVICES WITH REMOTE SERVER DATA".

9. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: "set-top box", "lean-forward activities", "GSM", "WAP", and "CDPD" and "non-PC initiated".

10. The use of the trademarks TiVo, TV Guide, Amazon.com, Philips Electronics, Pronto, WebTV, America On Line, SmartConnect, Jini, HAVi, and Web Pad have been noted in this

application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

11. Claims 1-19 are objected to because of the following informalities: “CE” is used to describe the system in the claim, but “CE” is never specifically defined. Appropriate correction is required.

12. Claim 4 is objected to because of the following informalities: “PC” should read “personal computer”. Appropriate correction is required.

13. Claims 10 and 17 are objected to because of the following informalities: the full term for “PVR” should be used in place of said acronym. Appropriate correction is required.

14. Claim 15 is objected to because of the following informalities: “form” should read “from” in the fifth line of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 2 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
17. Claim 2 recites the limitation "the CE first system" in the second line. There is insufficient antecedent basis for this limitation in the claim.
18. Claim 12 recites the limitation "the user" in the second line. There is insufficient antecedent basis for this limitation in the claim.
19. Claim 16 recites the limitation "the second system" in the seventh line. There is insufficient antecedent basis for this limitation in the claim.
20. Claim 17 recites the limitations "the first system" and "the second system" in the first line. There is insufficient antecedent basis for these limitations in the claim.
21. Claim 19 recites the limitation "the user's CE apparatus" in the fourth and sixth line. There is insufficient antecedent basis for these limitations in the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

22. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent 6,012,088 to Li, et al.

23. As to claim 1, Li discloses a method of enabling a consumer to program a device for operation, comprising enabling the consumer to interact with a server for generating control data to program the equipment [col. 9, lines 20-28, and col. 9, lines 50-61]. Li teaches the consumer contacts and interacts with the ISP server to generate the control data for programming the equipment.

24. As to claim 2, Li discloses downloading the control data from the server [col. 22, lines 64-67]. Li teaches the control data is downloaded from the server and used to configure the equipment, substantially as claimed.

25. As to claims 3 and 4, Li discloses downloading the control data to a further system for programming the equipment upon transfer of the control data from the further system to the equipment [col. 18, lines 2-6]. Li discloses a further system to be used by the consumer to communicate with the server to access and retrieve control information for the equipment to be programmed [col. 9, lines 20-28, and col. 9, lines 50-61]. It would be obvious to one of ordinary skill in the art to employ devices such as a set-top box, a PC, a telephone, or any other communications means to communicate with the server system. Furthermore, Li teaches that a trained network operator is available for determining configuration information as needed by the consumer [col. 2, lines 45-52]. It would be obvious to one of ordinary skill in the art to use a telephone to communicate with a human operator to interact with the server application to generate the control data, substantially as claimed.

26. As to claim 5 and 7, Li discloses the consumer interacts with the server via a further system different from the equipment to be programmed [col. 18, lines 2-6]. Li discloses the device serving as the further system to set the control information may be different from the equipment to be programmed, and by being separate, necessarily remote from said equipment.

27. As to claim 6, Li discloses the server provides respective applications for being interacted with via further systems [col. 9, lines 20-28, and col. 9, lines 50-61]. Since the consumer is interacting with the server to generate the control data, it is inherent that the server provides an application to enable the interaction, substantially as claimed.

28. As to claim 8, Li discloses the consumer requests the server to establish contact with the equipment [col. 22, lines 58-63] and the server establishes the contact in response to the consumer's request [col. 22, lines 60-65]. Li teaches the consumer sends a request to the server for control information, and that the server subsequently sends the requested configuration data.

29. As to claim 9, Li discloses the operation relates to configuring the equipment for selective processing of content information [col. 6, lines 50-57]. Li teaches the equipment must be configured properly so that it can be used, either on its own, or in conjunction with user input, to request, gather, process, send or display information.

30. As to claim 10, Li discloses the equipment comprises at least one of the following: a PVR, an audio jukebox, a television, or a home entertainment system [col. 25, lines 34-53, and col. 26, lines 1-8]. Li teaches that his method may be applied to any device that has output means for presenting information to the user that needs to be automatically configured with control data from a server, substantially as claimed. Further, Li teaches that his method is not restricted solely to computer systems, and that general-purpose machines, such as a PVR, an

audio jukebox, a television, or a home entertainment system, may be used with the configuration programs as taught by Li.

31. As to claims 11-12, Li discloses the consumer is enabled to interact with the application via speech input, for example, with a human operator who interacts with the server application based on the consumer's input [col. 9, lines 20-28, and col. 9, lines 50-61]. Since the consumer is interacting with the server to generate the control data, it is inherent that the server provides an application to enable the interaction, substantially as claimed. Furthermore, Li teaches that a trained network operator is available for determining configuration information as needed by the consumer [col. 2, lines 45-52]. It would be obvious to one of ordinary skill in the art to use such a human operator to serve as a facilitator, taking speech input from the consumer, and entering the necessary information into the server application to generate the control data, substantially as claimed.

32. As to claim 13, Li discloses the server has a database with information relating to the consumer [col. 9, lines 50-53] and the generation of the control data takes into account the information in the database [col. 9, lines 50-61].

33. As to claim 14, Li discloses a second consumer may program the equipment according the preferences of the second consumer via the network, a server application, and the subsequent generated control data [col. 9, lines 20-28, and col. 9, lines 50-61]. Because Li teaches the

method for one consumer, Li teaches the method may be used by a second consumer to program the equipment, substantially as claimed.

34. As to claim 15, Li discloses a method for enabling a consumer to control a device, the method comprising:

[a] enabling the consumer to interact with a first platform that generates control data to configure the device [col. 9, lines 20-28];

[b] enabling the device to be configured according the control data [col. 22, lines 64-67, and col. 23, line 1]; whereupon

[c] the consumer is able to interact with a second platform, for selecting an operational mode for the device [col. 18, lines 2-6].

35. As to claim 16, Li discloses an electronic apparatus comprising a device and a further system for being configured by a consumer wherein:

[a] the device is configurable for operation according to a user's preference [col. 25, lines 48, and col. 26, lines 1-8];

[b] the further system is network-enabled for user-interaction via a data network with an application server [col. 9, lines 20-28], the application server generating control data based on the consumer's preference [col. 9, lines 50-61]; and

[c] the further system configures the device based on the control data received from the server [col. 22, lines 64-67, and col. 23, line 1].

36. As to claim 17, Li discloses the device comprises a PVR and the second system comprises a set-top box [col. 25, lines 34-53, and col. 26, lines 1-8]. Li teaches that his method may be applied to any device that has output means for presenting information to the user that needs to be automatically configured with control data from a server and that the method is not restricted solely to computer systems, so that general-purpose machines, such as a PVR, may be used with the configuration programs as taught by Li. Li also discloses a further system to be used by the consumer to communicate with the server to access and retrieve control information for the equipment to be programmed [col. 9, lines 20-28, and col. 9, lines 50-61]. It would be obvious to one of ordinary skill in the art to employ any suitable communication means, such as a set-top box to perform this function.

37. As to claim 18, Li discloses control data generated by an application server for configuring a system based on a preference specified by the consumer [col. 9, lines 50-61].

38. As to claim 19, Li discloses a method of doing business comprising:

- [a] receiving via a first apparatus of end-user information about a preference regarding a configuration of a second apparatus [col. 9, lines 20-28];
- [b] generating configuration data for the second apparatus according to the preference [col. 9, lines 50-61]; and
- [c] sending the configuration data to the end-user for configuring the second apparatus [col. 9, lines 20-28, and col. 9, lines 50-61] so that the second apparatus is controllable by the end-user through a third apparatus during use of the second apparatus [col. 7, lines 58-63].

Li teaches the consumer communicates end-user information about a preference regarding a second apparatus with the server; it is obvious to one of ordinary skill in the art that a first apparatus be used as a communications means. Furthermore, Li teaches that a third apparatus, such as a keypad, may be used to control the second apparatus when said second apparatus has been properly configured according to the configuration data, substantially as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Chang whose telephone number is (703) 305-4612. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Lee can be reached on (703) 305-9717. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

ec
October 17, 2002



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